

**REMARKS**

In the Office Action,<sup>1</sup> the Examiner:

rejected claims 1-42 and 44<sup>2</sup> under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Publication No. 2005/0137901 to Siegel ("Siegel"); and

rejected claim 43 under 35 U.S.C. § 103(a) as unpatentable over Siegel in view of U.S. Publication No. 2001/0032143 to Haseltine ("Haseltine").

Claims 1-44 are pending.

Applicant respectfully traverses the rejection of claims 1-42 and 44 under 35 U.S.C. §102(b) as anticipated by Siegel.

In order to properly establish that Siegel anticipates Applicant's claimed invention under 35 U.S.C. § 102(b), each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in a single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Claim 1 recites "communicating the captured disposition decision from the computer based first management system to a computer based second management system." Siegel does not disclose or even suggest at least this element of claim 1.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement of characterization in the Office Action.

<sup>2</sup> The Office Action states on page 2 that only claims 1-42 are rejected under 35 U.S.C. § 102(b). Since, however, an explanation for the rejection of claim 44 is provided in the same section as the explanation for the rejection of claims 1-42, Applicant assumes that claim 44 is also rejected under 35 U.S.C. § 102(b).

The Office Action alleges that Siegel discloses “communicating the captured disposition decision from the computer based first management system to a computer based second management system (abstract discusses crediting the customer’s account in response to disposition).” Office Action p. 3. But, the allegation of the Office Action is not correct.

In the abstract, Siegel states “[t]he present invention provides a method and system for processing returns at a return center. The return center accesses return rules of a merchant associated with an item of merchandise that has been returned by a customer. The item is then processed according to one or more of the return rules. The processing may include determining the eligibility of the return, notification to a merchant associated with the return, crediting of an account associated with the customer, and/or subsequent disposition of the return.” Siegel Abstract.

The Office Action’s interpretation of the Siegel abstract is noticeably different both from what Siegel actually discloses and from the recitations of claim 1. For example, as discussed above, the Office Action states that Siegel discloses “crediting the customer’s account in response to disposition,” but Siegel actually states that “processing may include . . . crediting of an account associated with the customer, and/or subsequent disposition of the return.” Importantly, Siegel does not state that the “disposition of the return” is communicated to the “customer’s account” as the Office Action alleges.

Siegel does not teach to the recitations of claim 1 at least because Siegel does not disclose “communicating the **captured disposition decision** from the computer based first management system to a computer based second management system.”

Even if the second management system of Siegel could constitute a “customer’s account,” which Applicant does not concede, there is no disclosure or suggestion in Siegel that the “customer’s account” is receiving the “captured disposition decision.” A “customer’s account” in Siegel, at best, receives some sort of transaction request to credit or debit funds in an account. But, funds in an account are not a “captured disposition decision.” There is no disclosure or suggestion in Siegel that the actual “disposition decision” is communicated to a “customer’s account.” Siegel only discloses that an account is “credit[ed].”

Accordingly, Siegel does not disclose or suggest the claimed feature of “communicating the captured disposition decision from the computer based first management system to a computer based second management system.” Even under the Office Action’s interpretation of Siegel, Siegel does not disclose or suggest “communicating the captured disposition decision” at least because the “second management system,” which the Office Action interprets as a “customer’s account,” does not receive the actual “disposition decision.” Rather, Siegel’s customer account receives only “credit” and therefore does not anticipate claim 1 under 35 U.S.C. § 102(b). The rejection should be withdrawn.

Notwithstanding the above discussion, claim 1 is allowable for at least the following additional reason. Claim 1 recites “triggering, in response to the captured disposition decision, at least one process in the computer based second management system.” Siegel does not disclose or even suggest this element of claim 1.

The Office Action alleges that Siegel discloses “triggering, in response to the captured disposition decision, at least one process in the computer based second

management system (fig. 5 depicts returning to vendor as triggered by the return decision.” Office Action p. 3. But, this interpretation of the Siegel is not correct.

For example, the Office Action asserts that “returning to vendor as triggered by the return decision” in Siegel constitutes the “at least one process in the computer based second management system” recited in claim 1. But, this cannot be. The Office Action has already construed the “second management system” as being equivalent to the “customer’s account” as discussed above. See Office Action p. 3. The Office Action cannot interpret the “second management system” as a “customer’s account” and as a “returning to vendor” action in interpreting the same claim. Thus, the Office Action has not satisfied its burden to present evidence of each and every element of the claim in issue being present within Siegel at least because of the inconsistent interpretation provided with respect to claim 1. Accordingly, the rejection of claim 1 is improper for at least this additional reason and the rejection should be withdrawn.

For at least the above reasons, independent claim 1 is not anticipated by Siegel. Claims 2-7 are allowable for at least the reason that they depend from allowable claim 1. Independent claims 8, 12, 18, 25, 29, 34, and 44, although of a different scope, include recitations similar to those discussed above in relation to independent claim 1 and are not anticipated by Siegel for reasons at least similar to those discussed above with respect to claim 1. Claims 9-11, 13-17, 19-24, 26-28, 30-33, and 35-42 are allowable for at least the reason that they depend from one of the allowable independent claims. Therefore, the Examiner should withdraw the rejection of claims 1-42 and 44 under 35 U.S.C. § 102(b).

Claim 43 depends from allowable independent claim 34 and therefore incorporates every element of claim 34. Since claim 34 is allowable, claim 43 is allowable for at least the same reasons as claim 34 inasmuch as Haseltine does not remedy the above discussed deficiencies of the independent claim. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 43, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

**CONCLUSION**

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: \_\_\_\_\_

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